



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/694,806 | 10/29/2003 | Wei Chang | BHT-3137-33 | 4533 |

7590 04/13/2006

TROXELL LAW OFFICE PLLC
SUITE 1404
5205 LEESBURG PIKE
FALLS CHURCH, VA 22041

EXAMINER

NGUYEN, JIMMY H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2629 | |

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,806

Applicant(s)

CHANG ET AL.

Examiner

Jimmy H. Nguyen

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicants' papers filed on 10/29/2003. Claim 1 is currently pending in the application. An action follows below:

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature, "a circuit chip module mounted to the second opening" in line 7 of claim 1, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Art Unit: 2629

3. Claim 1 is objected to under 37 CFR 1.75(a) because although this claim meets the requirement 112/2d, i.e., the metes and bounds are determinable, however, the following changes should be made:

i. -- the circuit board and positioned directly above -- should be inserted immediately before “to the second opening” in line 7, so as to make the invention of this claim consistent with the disclosure, see Fig. 4 which shows a circuit chip module 4 mounted to a circuit board 3 and not being contacted with the second opening 31; and

ii. “the improvements comprising that:” should be changed to --wherein--, in order to improve its form to conform with U.S. claim drafting practice.

It is in the best interest of the patent community that applicant, in his/her normal review and/or rewriting of the claims, to take into consideration these editorial situations and make changes as necessary.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Leong et al. (US 6,967,321 B2), hereinafter Leong.

As to claim 1, the claimed invention reads on the Leong reference as follows: Leong discloses a second embodiment of an optic mouse (46) (col. 1, lines 6-9 and col. 4, lines 33-37)

Art Unit: 2629

comprising a casing (best seen in Fig. 3) including a top member (see Fig. 3) and a bottom member (a base plate 48) fixed together, a first opening (a hole 56) being defined in the bottom member; a lens module (a lens housing 66, see Figs. 8 and 9) received in the casing and mounted to the first opening (56) (see Figs. 3 and 7); a circuit board (52) (see Fig. 3, col. 4, lines 42-44) fixed inside the casing, the circuit board defining a second opening (best seen Fig. 3) corresponding in position to the first opening (56); and a circuit chip module (a sensing housing (60) having an electrical chip (62) and a LED chip (84), both integrated thereon, see Fig. 8, col. 4, lines 39-47) mounted to the second opening (see Fig. 3); wherein the lens module (66) comprises a support (76) mounted to the first opening (see Fig. 7), a carrier formed on the support and carrying first lens (86) and second lens (44), and a reflection portion formed at a location adjacent to the second lens and having a top portion connected to a bottom of the first lens (see Fig. 8); and the circuit chip module (60, 62, 84) comprises a light source (84) and an optic sensor (62) that are positioned in correspondence to the first (86) and second (44) lenses, respectively. Accordingly, the elements in the claim are read in the Leong reference.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,927,759 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

| Pending Application 10/694,806 | US 6,927,759 B2 |
|--------------------------------|--------------------------------------|
| An optical mouse | An optical mousing (see claim 1) |
| A casing | A housing (see claim 1) |
| A top member | A top cover (see claim 1) |
| A bottom member | A bottom cover (see claim 1) |
| A first opening | An opening (see claim 1) |
| A lens module | A lens set (see claim 1) |
| A circuit board | A circuit board (see claim 1) |
| A circuit chip module | A detecting device (see claim 1) |
| A first lens | A first lens (see claim 1) |
| A second lens | A second lens (see claim 2) |
| A light source | An illumination device (see claim 1) |
| An optic sensor | A receiving portion |

8. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/610,767, hereinafter APP767, in view of Leong et al. (US 6,967,321 B2), hereinafter Leong.

Art Unit: 2629

As to claim 1, all limitations of this claim, such as an optical mouse, a casing (a housing), a circuit board, a lens module (a lens set), a light source (a laser source), a circuit chip module (a detecting device), an optical sensor (a receiving portion), and etc., is recited in claim 3 of APP767, except the invention defined by claim 3 of APP767 does not disclose an optical sensor and a light source, both integrated in the circuit chip module. However, Leong discloses a related optical mouse (see col. 1, lines 6-9) comprising an optical sensor (62) and a light source (84), both integrated in the circuit chip module (60) (see Fig. 8, col. 2, lines 14-17). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to integrate the optical sensor and a light source in the circuit chip module of the invention defined by claim 3 of APP767, in view of the teaching in the Leong reference, because this would significantly reduce a number of individual components parts that must be handled and automatically align some or all of the components of the device, as taught by Leong (see col. 2, line 64 through col. 3, line 5).

This is a provisional obviousness-type double patenting rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN
April 11, 2006



Jimmy H. Nguyen
Primary Examiner
Technology Division: 2629